

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DAVID S. HOOVER, FRED M. KIMOCK,
LESLIE L. BARKLEY and STEPHEN P. KOWALCHUK



Appeal No. 2004-0154
Application No. 09/307,261

ON BRIEF

Before FRANKFORT, NASE, and, DIXON Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 4 to 24 and 36 to 58, which are all of the claims pending in this application.¹

We AFFIRM-IN-PART.

¹ On page 1 of the brief, the appellants canceled claims 25 to 35, 59 to 77 and 80 to 83. We note that this cancellation of claims 25 to 35, 59 to 77 and 80 to 83 has not been clerically entered.

BACKGROUND

The appellants' invention relates to systems and methods for previewing an accessory on a person before purchasing the accessory (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Maloomian	4,261,012	Apr. 7, 1981
Hill	5,970,471	Oct. 19, 1999
Fay	5,983,201	Nov. 9, 1999
Dias et al. (Dias)	6,170,017	Jan. 2, 2001

Claims 1, 2, 4, 5, 8 to 16, 19 to 24 and 36 to 50 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fay in view of Dias.

Claims 6, 7, 17 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fay in view of Dias and Maloomian.

Claims 51 to 58 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fay in view of Hill.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 11, mailed March 25, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 10, filed February 24, 2003) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Claims 1, 2, 4 to 24 and 36 to 50

We will not sustain the rejection of claims 1, 2, 4 to 24 and 36 to 50 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to

Figure 1 of Fay is a block diagram showing the elements of a system enabling a customer to shop for a pair of fitted eyeglass frames from home or some other convenient location includes one or more customer diagnostic locations 10, each including an interrogator 11 for determining customer size and image information, i.e. one or more pictures of the customer's head and face, and an interface 13 to a remote electronic store (RES) 20. Color information about the customer's face preferably forms part of the customer image information. Customer identity information (contact data) is also obtained via interrogator 11 and interfaces with interface 13. After a customer 12 cooperates with the interrogator 11, the customer receives a password and other information needed by the customer to later communicate electronically, using a personal computer, with the remote electronic store 20.

The customer diagnostic location 10 may be an unmanned booth including all of the hardware and software needed to accomplish the two tasks of determining the customer information and communicating with the remote electronic store. A customer diagnostic location 10 may be located in any appropriate location, including on the premises of an optician or an optometrist. In another aspect of Fay's invention, a customer need not visit a customer diagnostic location at all if the customer has a digital camera. In such an instance, the customer can provide digital images from the

customer's home PC and whatever additional information is needed by the remote electronic store 20 to size the customer's photographic images.

The remote electronic store 20 provides through a customer diagnostic location interface 24 an available password for the customer diagnostic location to issue to a customer, although many other schemes are possible for ensuring that different customer diagnostic locations do not issue the same password. The customer diagnostic location interface 24 receives from a customer diagnostic location 10 a customer's size and image data along with the password assigned to the customer and any frame selection data acquired from the customer for use in limiting what frames the remote electronic store may later suggest to the customer. This frame selection data might include, for example, characteristics of the customer's lifestyle to help select out frames generally, or specific characteristics of the desired eyeglass frames, such as that the frames be lightweight or metal or plastic or particularly sturdy. This information is obtained by interrogator 11 via questioning, filling in electronic forms, or other methodologies, e.g. expert system questioning.

After leaving the customer diagnostic location 10, the customer 12 uses a personal computer 14 to connect to a customer interface 23 at the remote electronic store 20, providing a password to identify the customer to the store so the store can

retrieve the customer's size, image information, and frame selection data, if present. In the preferred embodiment of the Fay's invention, the remote electronic store 20 is accessed by a customer from a home personal computer over the Internet. The remote electronic store 20 includes an image fitter 21 for creating a fitted image, i.e. an image of a particular customer wearing a particular eyeglass frame where the frame has been fitted to the customer based on the customer size and image information. The store also includes a frame data store 22, which includes all of the information that the store needs to build an image of any frame fitted to any particular customer, and also includes frame product information, such as information about the weight of the frames, or the material the frames are made from.

The customer interface 23 transmits an image of a customer wearing a particular eyeglass frame, and accepts from the customer inputs, or choice indicators, indicating whether the customer would like to try on a different pair of eyeglasses, order a pair of eyeglasses already tried on, change any frame selection data, or discontinue shopping. If the customer wants to try on another pair, the customer interface 23 will display images of the eyeglass frames for sale. The particular eyeglass frames displayed in this situation might be limited based on the frame selection data provided by the customer to the remote electronic store, either through a customer diagnostic

location 10 as already explained or through the customer interface 23 of the remote electronic store.

Dias' invention relates to a method for coordinating the authentication of clients, aggregation of information, group transactions, and multi-phase commits across a group of servers. The preferred embodiment of Dias' invention relates to commerce on the World Wide Web. Dias' invention provides a method for coordinating single authentication of a client among a set of stores, such that a client, once prompted for authentication information, can execute transactions at any store or across any subset of stores without further prompting for authentication. One object of Dias' invention is to coordinate the integration of information from multiple stores. For example, it is desirable to integrate the items contained in the shopping basket of each store a client has visited and to provide a single display of this information to the client. As another example, it is desirable to allow a client to specify keywords for a search, send the search request to any subset of the stores, and send the combined search results to the client. A further object of Dias' invention is to coordinate requests for group transactions involving multiple stores. For example, a client may request a group purchase, which involves an "all-or-nothing" purchase of a set of items across stores. Such a purchase might involve, for example, a matching jacket and slacks from different stores.

The architecture of Dias' invention is a client-server environment having a server group including one or more participating servers and one or more controller servers, where each participating server can communicate with at least one controller server. In this environment, Dias' invention is directed to a method for coordinating actions among the servers in the server group, which comprises the steps of: (1) communicating between a client and at least one of the servers in the server group using a protocol that has limited or no defined procedures for passing state information between the client and the servers; (2) transmitting a request for an action from the client to one of the servers; and (3) communicating among a plurality of servers with at least one controller server coordinating actions of at least some of the servers in response to the request.

Based on our analysis and review of Fay and claims 1, 2, 4 to 24 and 36 to 50, it is our opinion that one difference is the limitation that the server computer is linked to different accessory-provider computer sites respectively having different accessories for viewing.²

With regard to this difference, the examiner determined that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the

² After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

computer at Fay's remote electronic store be a server computer linked to different accessory-provider computer sites respectively having different accessories for viewing, for the advantages taught by Dias. We do not agree. We agree with the examiner that the computer at Fay's remote electronic store is a server computer. Fay teaches that this server computer contains a database of information about different models of eyeglass frames, the information being sufficient to build an image of the eyeglass frame based on customer size information and that this database can be readily updated to accurately reflect changes and additions to this universe of available frames. The applied prior art does not teach or suggest that this database on the server computer is updated by being linked to different eyeglass-provider computer sites. While Dias may have suggested placing Fay's remote electronic store in a virtual mall having other virtual stores, this does not result in the claimed invention since the server computer which generates the claimed composite image (at Fay's remote electronic store) would still not be linked to different accessory-provider computer sites.³

For the reasons set forth above, the decision of the examiner to reject claims 1, 2, 4 to 24 and 36 to 50 under 35 U.S.C. § 103 is reversed.

³ The virtual mall's server computer would be linked to different accessory-provider computer sites, however, the virtual mall's server computer would not be the computer that generates the claimed composite image. Thus, the claimed subject matter, as a whole, is not suggested by the applied prior art.

Claims 51 to 58

We sustain the rejection of claims 51 to 58 under 35 U.S.C. § 103.

Claim 51 reads as follows:

A system for previewing an accessory before purchasing the accessory, the system comprising:

- a server computer comprising (i) a first computer program for selecting data of a first accessory image from an electronic database, (ii) a second computer program for generating data of a first composite image from data of the first accessory image and data of a person's image, (iii) a third computer program for selecting data of a second accessory image from the electronic database, and (iv) a fourth computer program for generating data of a second composite image from data of the second accessory image and data of the person's image;

- an information storage medium for saving data of the first composite image, the information storage medium being on or accessible to the server computer;

- a client computer operatively coupled with the server computer; and

- a display device for displaying the first and second composite images to a customer for simultaneously previewing accessories before purchasing, at least one of the composite images showing one of the accessories being worn on the person.

Hill's invention relates to a virtual product catalog and product inventory control and presentation apparatus and method. An apparatus and method are provided for presenting a plurality of product images for review by a user on a computer including a display, a memory, and an input device. The method includes the steps of displaying a plurality of product images on the display, providing product image review boxes on the

display for a side-by-side comparison of selected product images, receiving a user input selecting a product image from the plurality of product images displayed on the display, and displaying the selected product image in one of the review boxes for a side-by-side comparison with at least one other selected product image. The product images include both a product image and a selected background image. The step of displaying the selected product image includes the step of integrating the product image with a selected background image to provide a customized product image on the display. Figure 9 is a display screen generated on the computer at the sales location which includes an icon scroll box for reviewing images of products available in a selected category and four larger display boxes for displaying product items selected from the scroll box. Figure 13 is a screen displayed on the computer for reviewing selected images and data related to products selected and moved to the review boxes. This permits a side-by-side comparison of the particular products in which the customer is interested.

In the rejection of claim 51 before us in this appeal (answer, pp. 21-23 and 31-32), the examiner ascertained that Fay, either expressly or under the principles of inherency, taught each and every element except for the display device simultaneously displaying the first and second composite images to the customer. With regard to this difference, the examiner determined that it would have been obvious to one of ordinary

skill in the art at the time the invention was made to have modified Fay to simultaneously display first and second composite images to permit a side-by-side comparison of the particular products in which the customer is interested as suggested by the teachings of Hill.

The appellants argue (brief, pp. 8-10) that (1) Fay lacks a server computer; (2) no server computer in the applied prior art generates data of a second composite image of a first image (person) wearing a second accessory image; (3) the applied prior art does not teach an information storage medium on or accessible to the server computer for saving data of the first composite image; and (4) there is no motivation to have modified Fay to arrive at the subject matter of claim 51. We find the appellants' argument unpersuasive for the reasons which follow.

Fay has a server computer. A server computer is a computer that controls a central repository of data that can be downloaded and manipulated in some manner by a client computer. A client computer is a computer that can download files for manipulation from a server computer.⁴ Clearly, the computer at Fay's remote electronic store is a server computer since it controls a central repository of data that can be

⁴ Computer Dictionary, Third Edition, Microsoft Press, 1997.

downloaded and manipulated in some manner by the customer's personal computer (i.e., the client computer).

It is well-settled that nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. See In re Merck & Co. Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986). Thus, while no server computer in the applied prior art generates data of a second composite image of a first image (person) wearing a second accessory image, the combined teachings of the applied prior art would have suggested to one of ordinary skill in the art that Fay's server computer generate data of a second composite image of a first image (person) wearing a second accessory image as set forth in the examiner's rejection.⁵

Fay does teach an information storage medium on or accessible to the server computer for saving data of the first composite image. While Fay does not expressly disclose an information storage medium on or accessible to the server computer for saving data of the first composite image, Fay does disclose that the customer can order a pair of eyeglasses already tried on (column 6, lines 4-9 and 33-53). This inherently

⁵ The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

teaches a storage medium storing a record of which eyeglasses have been tried on. Claim 51 does not recite "an information storage medium for saving all data of the first composite image," but "an information storage medium for saving data of the first composite image" (emphasis added). Thus, claim 51 reads on a medium which saves some data from the first composite image, such as records of which eyeglass frames were used in forming composite images of customers wearing eyeglasses, which is what is inherent from the teachings of Fay. Furthermore, since claim 51 recites no requirement that the data of the first composite image be saved for an extended period of time, the limitation (i.e., an information storage medium for saving data of the first composite image, the information storage medium being on or accessible to the server computer) is met by a buffer which temporarily stores at least some data of the first composite image in the course of the first composite image being transferred to the customer's personal computer.

The motivation, suggestion or teaching to combine references may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game

Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d at 425, 208 USPQ at 881 (and cases cited therein). In our view, there is ample motivation for a person of ordinary skill in the art to have modified Fay to arrive at the subject matter of claim 51. In that regard, Hill clearly teaches permitting a side-by-side comparison of the particular products in which the customer is interested. This teaching of Hill provides the motivation for one of ordinary skill in the art at the time the invention was made to have modified Fay to simultaneously display first and second composite images to permit a side-by-side comparison of the particular products in which the customer is interested.

For the reasons set forth above, the decision of the examiner to reject claim 51 under 35 U.S.C. § 103 is affirmed.

The appellants have grouped claims 51 to 58 as standing or falling together.⁶ Thereby, in accordance with 37 CFR § 1.192(c)(7), claims 52 to 58 fall with claim 51. Thus, it follows that the decision of the examiner to reject claims 52 to 58 under 35 U.S.C. § 103 is also affirmed.

⁶ See page 4 of the appellants' brief.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 4 to 24 and 36 to 50 under 35 U.S.C. § 103 is reversed and the decision of the examiner to reject claims 51 to 58 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART



CHARLES E. FRANKFORT
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge



JOSEPH L. DIXON
Administrative Patent Judge

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